



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/847,443 | 05/03/2001 | Osamu Ichiyoshi | Q64369 | 5717 |

7590 02/24/2005
SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,443

Applicant(s)

ICHIYOSHI, OSAMU

Examiner

Yasin M Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. The amendment filed on October 15, 2004 has been fully considered but are moot in view of the new ground(s) of rejection.
2. Claims 1-14 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. Also, it is improper method claim [no positively recited method step].
- Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (The address defined in the telephone network is used in place of an Internet protocol address). It is not clear from the specification how it is done.

- Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (The address defined in the telephone network is used in place of an Internet protocol address).
- Claims 8 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. (Providing a second network and a server on at least the second network). There are no first network and second network as claimed by the applicant according to fig. 3 of the applicant's present invention and corresponding pages of the specification. The only network shown according to fig. 3 of Applicant's present invention is network 20. All terminal and the address server are connected to network 20.

- Claims 8 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (Providing a second network and a server on at least the second network). There are no two networks as claimed by the applicant according to fig. 3 of the applicant's present invention. The only network shown according to fig. 3 of Applicant's present invention is network 20. All terminal and the address server are connected to network 20.

- Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address, then the communication with the terminating side computer is in IP mode).
- Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address,

then the communication with the terminating side computer is in IP mode).

- Claim 12 recites the limitation "the apparatus " in line 1. There is insufficient antecedent basis for this limitation in the claim.
- Claim 13 recites the limitation "the method " in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do

not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 7-8, 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabatier et al USPN (6754708).

As per claim 1, Sabatier et al teach a computer communication network (fig 1), wherein a computer is specified by an address defined in a telephone network (col. 2, lines 47-66 and col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65).

As per claim 2, Sabatier et al teach a computer communication network according to claim 1, wherein the address defined in the telephone network is used in place of an Internet protocol address [col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 6, lines 6-45].

As per claim 3, Sabatier et al teach a computer communication network according to claim 1, wherein the address is a telephone number [col. 3, lines 21-32 and lines 58-67].

As per claim 4, Sabatier et al teach a computer communication network according to claim 1, wherein the address is a number in the Integrated Service Digital Network [col. 2, lines 47-57].

As per claim 5, Sabatier et al teach a computer communication network according to claim 1, comprising:

an address server (server 5) for correlatively storing the address defined in the telephone network and a name corresponding to the address [col. 2, lines 20-35; col. 3, lines 11-32 and col. 6, lines 50-67],

wherein the computer on a originating side comprises:

means for inquiring of the address server about the address corresponding to a name of a computer on a terminating side [abstract and col. 3, lines 11-32]; and

means for calling the address received from the address server col. 3, lines 33-64 and col. 6, lines 6-67].

As per claim 7, Sabatier et al teach a computer communication network according to claim 5, wherein the address server is an exchanger [server 5, col. 3, lines 7-10].

As per claim 8 and 11, Sabatier et al teach a method and a system for communications on a computer network (fig. 1 and abstract), comprising:

providing a first network (network 4, fig. 1);

providing a second network (network 3, fig. 1);

providing a first computer (terminal 1, fig. 1) identified by a unique address on at least the first network (telephone number as identifier N1);

providing at least one second computer (terminal 2, fig. 1) identified by a unique address on at least the first network (telephone number as identifier N2) providing a server (server 5) on at least the second network (network 3, fig. 1);

communicating with the server from the first computer to initially determine the address of the at least one second computer by communicating on the second network (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65); and

connecting to the at least one second computer on the first network using the address of the at least one second computer provided by the server (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 5, lines 17-28), wherein the first network is a telephone network (STN 4, fig. 1 and col. 2, lines 62-66).

As per claims 14, Sabatier teach computer communication network according to claim 5, wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns a Public Switched

Art Unit: 2153

Telephone Network (PSTN) number, then the communication with the terminating side computer is in PSTN mode (col. 3, lines 51 to col. 4, line 3 and col. 4, lines 52-65; col. 5, lines 17-28), and wherein if the inquiring of the address server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address, then the communication with the terminating side computer is in IP mode (col. 6, lines 50 to col. 7, line 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier et al USPN (6754708 in view of Szutu US PUB. (20010047395).

As per claim 6, although Sabatier et al shows substantial features of the claimed invention, he does not explicitly show where the names in the computer communication network is not duplicated.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Sabatier et al, as evidenced by Szutu US PUB. (20010047395).

In analogous art, Szutu whose invention is about a network system for interactively linking a network-independent unique identifier to network resources, discloses domain names in a computer communication network (a network-independent preexisting-unique identifier) that is unique (not duplicate) provided and governed by an Internet-independent administrative authority. Because the names are unique they are not the same as any of the domain name in the Internet [¶ 0010-0011 and ¶ 0017-0018]. Giving the teaching of Szutu, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Sabatier et al by employing the system of Szutu for interactively linking a network-independent unique identifier to network resources. One would be motivated to do so because it provides a unique way of identifying Internet web resources.

5. Claims 9-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatier et al USPN. (6754708) in view of Yablon USPN. (5764731).

As per claim 9 and 12, Although Sabatier et al shows substantial features of the claimed invention, he does not explicitly show storing the address of the at least one second computer on the first computer so that subsequent connections to the at least second computer do not require communicating with the Server. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Sabatier et al, as evidenced by Yablon USPN. (5764731).

In analogous art, Yablon whose invention is about an enhanced system for transferring, storing and using signaling information in a switched network, discloses storing the address (telephone number) of the at least one second computer (second telephone device) on the first computer (on the memory of first telephone device) so that subsequent connections to the at least second computer do not require communicating with the Server. [Col. 12, lines 3-40 and col. 23, lines 1-19]. Giving the teaching of Yablon, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Sabatier et al by employing the system of Yablon. One would be motivated to do so because it provides user a quick way of

Art Unit: 2153

establishing communications with other user devices absent of server intervention [col. 23, lines 1-19]

As per claims 10 and 13, Sabatier teach the invention, wherein the connection to the at least second computer on the first network does not use the second network (direct communication through STN 4 could be established between the terminals col. 5, lines 17-23).

Conclusion

6. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2153

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

Art Unit 2153



ANTON J. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100